

### REMARKS

This application has been reviewed in light of the Office Action dated June 11, 2008. Claims 1-3, 6, 9, 11 and 13 are presented for examination, of which Claims 1, 11, and 13 are in independent form. Claims 4, 5, 7, 8, 10, 12, and 14-19 have been cancelled, without prejudice or disclaimer of the subject matter presented therein. Claims 1-3, 6, 11, and 13 have been amended to define Applicant's invention more clearly. Favorable reconsideration is requested.

The Office Action rejected the abstract of the disclosure as being outside the prescribed range of 50-150 words. The abstract has been carefully reviewed and amended accordingly. Withdrawal of this objection is therefore respectfully requested.

The Office Action rejected Claims 16-19 under 35 U.S.C. §101 as directed to non-statutory subject matter. Although it is not conceded that the rejection is correct or valid, Claims 16-19 have been canceled without prejudice or disclaimer of subject matter presented therein in an effort to expedite the allowance of this application. Accordingly, cancellation of Claims 16-19 renders the rejection of those claims moot.

The Office Action rejected Claims 1-3, 9, 10, 12, and 16 under 35 U.S.C. §102(b) as being anticipated by U.S. Pat. No. 5,774,624 (*Enari*); and rejected Claims 4-8, 11, 13-15, and 17-19 under 35 U.S.C. §103(a) as being unpatentable over *Enari* in view of U.S. Pat. No. 6,556,627 (*Kitamura et al.*).

Applicant points to Claim 1, which recites “a communications unit configured to communicate the encoded image signal generated by said encoding unit to an external device while the signal is in an encoded state, wherein the encoded image signal is transmitted to the

external device while the encoded image signal is not recorded” and “a controller configured to control, upon detection of the instruction and while the encoded image signal is transmitted to the external device, said recording unit to start recording the encoded image signal from the leading end of a picture group that contains a frame, which corresponds to the instruction.” By virtue of these features, the beginning part of the encoded image signal is prevented from being recorded in a form that cannot be decoded when an instruction to start recording the encoded image signal is detected while the encoded image signal is being transmitted to the external device.

As best understood by the Applicant, the *Enari* system encodes an inputted image signal and records the encoded image signal. Apparently, encoding of the inputted image signal is started in response to a recoding instruction.

Nothing has been found in *Enari* that would teach, suggest or otherwise result in “communicat[ing] the encoded image signal generated by said encoding unit to an external device while the signal is in an encoded state, wherein the encoded image signal is transmitted to the external device while the encoded image signal is not recorded” much less “control[ling], upon detection of the instruction and while the encoded image signal is transmitted to the external device, said recording unit to start recording the encoded image signal from the leading end of a picture group that contains a frame, which corresponds to the instruction,” as recited in amended Claim 1. Indeed, Applicant submits that *Enari* even fails to mention transmitting an encoded image signal to an external device while the encoded image signal is not being recorded. In addition, *Enari* is silent about how recording is controlled if a start instruction to start recording the encoded image signal is detected while the encoded image signal is being transmitted to the external device.

Accordingly, Applicant submits that Claim 1 is not anticipated by *Enari*, and respectfully requests withdrawal of the rejection under 35 U.S.C. § 102(b).

As understood by the Applicant, *Kitamura et al.* disclose encoding an input signal and outputting the encoded signal. *Kitamura et al.* also do not transmit an encoded image signal to an external device while the encoded image signal is not being recorded and are silent about how recording is controlled if a start instruction to start recording the encoded image signal is detected while the encoded image signal is being transmitted to the external device.

Accordingly, Applicant submits that amended Claim 1 is allowable over *Kitamura et al.*

Independent Claims 11 and 14 include features similar to those discussed above with respect to Claim 1. Therefore, those claims also are believed to be patentable for at least the same reasons as discussed above.

In addition, based on the above reasoning, Applicant further submits that the Office cannot sufficiently establish a *prima facie* case of obviousness against amended Claims 11 and 13, and that the proposed combination of *Enari* and *Kitamura et al.*, even if deemed legally permissible or technically feasible, would fail to arrive at the apparatus and method of Claims 11 and 13, respectively. Accordingly, the rejection under 35 U.S.C § 103(a) is deemed obviated, and its withdrawal is respectfully requested.

The other rejected claims in this application depend from Claim 1 discussed above and, therefore, are submitted to be patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, individual reconsideration of the patentability of each claim on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

No petition to extend the time for response to the Office Action is deemed necessary for the this Amendment. If, however, such a petition is required to make this Amendment timely filed, then this paper should be considered such a petition and the Commissioner is authorized to charge the requisite petition fee to Deposit Account 50-3939.

Applicant's undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,

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